Decision for dispute CAC-UDRP-102275

Case number	CAC-UDRP-102275
Time of filing	2018-12-20 15:11:03
Domain names	earthtalentbybollore.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	BOLLORE

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	gazanfer yaman

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registrant of the international trademark registration No. 704697, “Bolloré”, registered on December 11, 1998, for goods and services in classes 16, 17, 34, 35, 36, 38, 39.

The Complainant is also the registrant of the EU trademark registration No. 12998852, “earthtalent”, registered on November 7, 2014, for goods and services in classes 16 35, 36, 41, 45.

The disputed domain name was registered by the Respondent on December 14, 2018

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant states that the Bolloré group, which is one of the 500 largest companies in the world, was founded in 1822.

The Complainant points out that it is listed on the Paris Stock Exchange and that it holds strong positions in Transportation and Logistics, Communication and Media, Electricity Storage and solutions.

The Complainant underlines that the majority interest of the group's stock is controlled by the Bolloré family.

The Complainant adds that the group also manages a number of financial assets including plantations and financial investments.

The Complainant submits that "Earthtalent by Bolloré" is an international-scale collaborative program, put forward by the Bolloré group's employee, to support solidarity projects contributing to local development.

The Complainant points out that it is the owner of several international trademarks containing the word “BOLLORE”, as well as various trademarks “Earth Talent”.

The Complainant adds that it is also the owner of number of domain names that contain the distinctive word “BOLLORE”, including the domain name <bollore.com>, registered on July 25, 1997. The Complainant submits that it is also the owner of various domain names “earthtalent”, including the domain names <earthtalent.org> and <earthtalent.net>, both registered on July 24, 2008.

The Complainant observes that the disputed domain name refers to the Registrar landing page.

The Complainant argues that the disputed domain name is confusingly similar to its trademarks, in particular the trademark “BOLLORE”, because it is well established that a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for the purposes of the UDRP

The Complainant contends that the Respondent does not have any rights or legitimate interest in the disputed domain name.

The Complainant observes that it is required to make out a prima facie case that the Respondent lacks rights or legitimate interest and, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. The Complainant adds that if the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Complainant argues that the Respondent is not known as “earthtalentbybollore”, but has a completely different name.

The Complainant contends that the Respondent is not affiliated with nor authorized by it in any way.

The Complainant states that it does not carry out any activity for, nor has any business with the Respondent.

The Complainant underlines that neither licence nor authorization has been granted to the Respondent to make any use of the Complainant’s trademarks.

The Complainant points out that it has never delegated the Respondent to apply for registration of the disputed domain name on behalf of the Complainant.

The Complainant observes that the fact that the disputed domain name refers to the Registrar landing page confirms that the Respondent has no demonstrable plan to use the disputed domain name.

The Complainant submits that, given the distinctiveness and reputation of the Complainant's trademark, the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.

The Complainant asserts that, under the doctrine of the passive holding, the Respondent has registered and is using the disputed domain name in bad faith.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

(i) The Disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed domain name; and

(iii) The Disputed domain name has been registered and is being used in bad faith.

DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademarks, “Bolloré” and “earthtalent”, identified in section “Identification of rights” above. The Complainant submitted also evidence of other registered trademarks, however the Panel, pursuant to point 8 of the CAC‘s UDRP Supplemental Rules, disregarded them because no translation in the language of the proceedings was submitted.

The Panel observes that both Complainant's trademarks predate the registration of the disputed domain name.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant’s trademarks.

The disputed domain name differs from the Complainant’s trademark “Bolloré” only by the wording “earthtalentby” at the beginning of the domain, by the use of letter “e” without accent at the end of the domain name, and by the top-level domain “.com”.

As found in a number of prior cases decided under the Policy, where the relevant trademark is recognizable within the domain name, the addition of other non-distinctive terms does not prevent a finding of confusing similarity (see, for example, WIPO case No. D2008-2002). In addition, the disputed domain name combines the Complainant's registered trademark "Bolloré" as its distinctive element with the generic terms "earth", "talent" and "by", which are related to one of its activities, namely the international-scale collaborative program named "Earthtalent by Bolloré". The fact that the wording "earthtalent" is also registered by the Complainant as trademark, and it is used by the Complainant in various domain names, increases the risk of association of the Complainant's trademark with the disputed domain name.

It is well established that the difference between the use of a letter without accent and the use of a letter with accent is immaterial to the purpose of the comparison (see, for example, WIPO case No. D2016-1300).

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark "Bolloré".

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- it does not carry out any activity for the Respondent;

- the Respondent is not affiliated to the Complainant;

- the Respondent does not have any business with the Complainant;

- the Respondent has not been authorized to by the Complainant in any way;

- the Respondent has no license or authorization to make any use of the Complainant's trademarks;

- the Respondent has not been authorized by the Complainant to register the disputed domain name;

- the Respondent is not commonly known by the disputed domain name.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, the disputed domain name refers to the Registrar landing page.

Taking into account that the Respondent is not commonly known as the disputed domain name, that the Respondent has no connection or business relationship with the Complainant, that the Complainant has not authorized the Respondent to register the disputed domain name or to use the Complainant's trademarks, that the disputed domain name points to the Registrar landing page, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a

competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

The Panel observes that it is well established that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative. Therefore, even where a complainant is not able to demonstrate the literal application of one of the above-mentioned scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behaviour detrimental to the complainant's trademark would also satisfy the complainant's burden.

Taking into account the distinctiveness and reputation of the trademark "Bolloré" also recognized by other Panels, the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark "Bolloré" when registering the disputed domain name. The fact that the disputed domain name includes also the Complainant's trademark "earthtalent", reinforces the above-mentioned argument. Other panels considered that knowledge of a corresponding mark at the time of the domain name's registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and the Panel share this view.

The fact that the disputed domain name is currently parked and not used does not prevent a finding of bad faith (see, for example, WIPO Case No. D2018-1264). Previous panels have indeed confirmed that the prerequisites under paragraph 4(a)(iii) of the Policy can be met under the doctrine of passive holding, giving close attention to all circumstances of the Respondent's behaviour (see, for example, WIPO Case No. D2000-0003).

The Panel, having taken into account the distinctiveness and reputation of the Complainant's trademark, the fact that also another trademark owned by the Complainant is included in the disputed domain name, the fact that no response to the Complaint has been filed, and the passive holding of the disputed domain name, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **EARTHTALENTBYBOLLORE.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2019-01-24

Publish the Decision